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Paper No. 6

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In re Application of
Zhang, Thwin, Wu, Cho, and Gallagher
Application No. 09/203,078
Filed: 1 December, 1998
Attorney Docket No. INRP:081

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the petition under 37 CFR 1.47(a) filed on 13 April, 1999.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 1 December, 1998, without an executed oath or declaration and naming Shuyuan Zhang, Capucine Thwin, Zheng Wu, Toohyon Cho, and Shawn Gallagher as joint inventors.

Accordingly, on 15 April, 1999, a "Notice To File Missing Parts Of Application" was mailed, requiring an executed oath or declaration, a filing fee and additional claim fees, and a surcharge for late filing.

In response, on 15 April, 1999, a petition was filed under 37 CFR 1.47(a). Petitioner additionally submitted the following: (a) a declaration signed by inventors Zhang, Thwin, Wu, and Gallagher; (b) an affidavit of Onita Cheyne; (c) a copy of the cover letter sent with the application and declaration via Federal

Express to the non-signing inventor, and (d) the non-signing inventor's last known address.

The petition states that a copy of the application papers were forwarded by Federal Express to Dr. Cho's last-known address on 31 March, 1999, but were returned as undeliverable on 5 April, 1999.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (3). In regards to requirement (1), petitioner has not submitted sufficient evidence to show that diligent efforts have been made to locate the non-signing inventor. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. Petitioner should provide a copy of the Federal Express airbill marked and returned as undeliverable in addition to any other official transmission report pertaining to this mailing and received from Federal Express.

In regards to requirement (2), the declaration is not acceptable because it does not list the residence, post office address, and citizenship for the non-signing inventor.¹ Petitioner must submit a new oath or declaration including the above-referenced information.

As previously authorized, petitioner's Deposit Account, No. 01-2508, will be charged the \$130.00 petition fee required by law.

¹ 37 CFR 1.63 and MPEP 409.03(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.



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